

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Sung-hee HWANG et al.

Application No. 10/797,105

Group Art Unit: 2627

Confirmation No. 4574

Filed: March 11, 2004

Examiner: Thomas D. Alunkal

For: WRITE ONCE DISC, DISC DRIVE THEREFOR, AND METHOD OF MANAGING DISC
DEFECT CONSIDERING COMPATIBILITY WITH REWRITABLE DISC DRIVE

PETITION UNDER 37 CFR §1.181

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby respectfully petition from the premature designation of Paper No. 20070501 as "Final" Office Action, request withdraw of the designation of "Final" for a complete Office Action and restarting of a period for response, and as reasons therefore, state that;

STATEMENT OF FACTS

1. On March 11, 2004, the application was filed in the USPTO in which claims 1-38 were presented for examination.
2. On November 14, 2006, the Examiner issued the first Office Action (Paper No. 20061102) rejecting all claims 1-38 under 35 U.S.C. §103(a) as being unpatentable over Kim et al., U.S. Patent No. 6,564,345, as modified to incorporate selected features from Lin, U.S. Patent No. 7,000,152.
3. On February 14, 2007, Applicants traversed the rejection of claims 1-38 under 35 U.S.C. §103(a) as being unpatentable over Kim '345 in view of Lin '152, and amended independent claims 1, 3, 9, 11, 13, 17, 21 and 25. However, independent claim 5 was never amended.
4. On May 10, 2007, the Examiner issued a premature "Final" Office Action (Paper No. 20070501) rejecting all pending claims 1-25 and 27-38 under a new statutory provision, 35 U.S.C. §102(e) as being anticipated by a different, newly cited prior art, Park et al., U.S. Patent No. 7,188,271.

REMARKS

MPEP §707.07(a) defines a premature Final Office Action as one:

“where the Examiner introduce a new ground of rejection not necessitated by amendment of the application by applicant.”

Further, MPEP §707.07(a) also describes that:

“A second or any subsequent action on the merits in any application...should not be made Final *if it includes a rejection, on prior art not of record, of any claims amended to include limitations which should reasonably have been expected to be claim.* See MPEP §904. For example, one would reasonably expect that a rejection under 35 U.S.C. §112 for the reason of incompleteness would be responded to by an amendment supplying the omitted element.”

In the present situation, the Examiner has clearly instituted a new ground of rejection based upon on a newly cited prior art reference, namely Park et al., U.S. Patent No. 7,188,271, in order to support the rejection under 35 U.S.C. §102(e) of claims 1-25 and 27-38. Of course, under MPEP §707.07(a), the Examiner cannot introduce a new prior art, raise a new ground rejection not necessitated by Applicants' Amendment filed on February 14, 2007, and make that Office Action “Final”.

CONCLUSION

In view of the foregoing facts and explanations, Applicants respectfully request the Commissioner to: (1) withdraw the designation of Paper No. 20070501 mailed on June 10, 2007 as a “Final” Office Action; (2) reissue another Office Action as required by MPEP §707.07(f) be issued, and that the period for response be restarted; and (3) grant such and other relief as justice may require.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

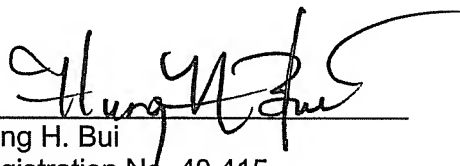
Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: _____

5/23/07

By: _____



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